

U.S. Serial No. 10/616,123  
Attorney Docket No. KMC-585

### REMARKS

The applicants have carefully considered the Office action dated May 10, 2006 and the references it cites. By way of this Response, claims 13-29 have been added. Claims 1, 4, 5, and 13-29 are pending at issue, with claims 1, 17, and 23 being independent. As explained below, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

In the Office action dated May 10, 2006, claims 1, 4 and 5 were rejected as unpatentable over Beebe et al. (U.S. Patent No. 6,186,903) in view of Yoneyama (JP 10-277186) and Nishitani (JP 2001-190720). The applicants respectfully traverse each of the rejections.

The applicants respectfully submit that independent claims 1, 17, and 23 are patentable over the art cited in the Office action. In one example, independent claim 1 recites, *inter alia*, a golf club head having an interior wall being integrally formed on a bottom surface of a primary cavity and extending from the bottom surface of the primary cavity in a direction that is substantially perpendicular to a longitudinal axis of a hosel to form an included acute angle between the interior wall and the bottom surface of the primary cavity. None of the cited references, whether taken alone or in combination, teach or suggest such a structure.

In particular, Beebe et al. fail to disclose or suggest an interior wall being integrally formed on a bottom surface of a primary cavity and extending from the bottom surface of the primary cavity in a direction that is substantially perpendicular to a longitudinal axis of a hosel to form an included acute angle between the interior wall and the bottom surface of the primary cavity. In contrast, Beebe et al. describe an interior wall (56) being integrally formed on a bottom surface (54) of a primary cavity (26) and extending from the bottom surface (54) of the primary cavity (26) in a direction "D<sub>1</sub>" that is not substantially perpendicular to a longitudinal

U.S. Serial No. 10/616,123  
Attorney Docket No. KMC-585

axis "A<sub>1</sub>" of a hosel (14) to form a right angle " $\theta_2$ " between the interior wall (56) and the bottom surface (54) of the primary cavity (26). See Appendix A, which reproduces FIGs. 8 and 9 of Beebe et al. As depicted in FIG. 8 of Appendix A, for example, the longitudinal axis "A<sub>1</sub>" forms a non-right angle " $\theta_1$ " with a plane in the direction "D<sub>1</sub>" instead of forming a substantially right angle. By extending in the direction of D<sub>1</sub>, the interior wall (56) forms a right angle " $\theta_2$ " with the bottom surface (54) instead of forming an acute angle. Therefore Beebe et al. does not teach or suggest the structure as recited in claim 1.

Neither Yoneyama nor Nishitani can overcome the deficiencies of Beebe et al. In particular, as explained above, Beebe et al. depicts an interior wall extending in a direction that is not substantially perpendicular to a longitudinal axis of a hosel to form a right angle between the interior wall and the bottom surface of the primary cavity. As such, to replace the interior wall of Beebe et al. with an interior wall extending from the bottom surface of the primary cavity in a direction that is substantially perpendicular to a longitudinal axis of a hosel would destroy the invention of Beebe et al. The law is quite clear that, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01, citing, *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959) (emphasis added). Accordingly, the examiner's proposed combination of Beebe et al. and Yoneyama unmistakably changes the principle of operation of the Beebe et al. invention, the proposed modification of Beebe et al. is improper as a matter of law and cannot render claim 1 obvious. Therefore, claim 1 and all claims dependent directly or indirectly thereon must be allowed.

New independent claim 17 is also allowable. Claim 17 recites, *inter alia*, a golf club head having a perimeter weighting element including a sole, and an interior wall integrally

**U.S. Serial No. 10/616,123**  
**Attorney Docket No. KMC-585**

formed on a bottom surface of a primary cavity and extending from the bottom surface of the primary cavity in a direction that is substantially perpendicular to a longitudinal axis of a hosel so that the interior wall is substantially parallel to a surface when the sole is resting on the surface. As explained above, no combination of Beebe et al. and any other reference of record teaches or suggests such a structure. Accordingly, independent claim 17 and all claims dependent directly or indirectly thereon are allowable.

New independent claim 23 is also allowable. Claim 23 recites, *inter alia*, a golf club head having a perimeter weighting element including a sole, and an interior wall integrally formed on a bottom surface of a cavity and extending from the bottom surface of the primary cavity in a direction that is substantially perpendicular to a longitudinal axis of a hosel so that the interior wall defines a tuning port having a first inner surface and a second inner surface that are substantially parallel to a surface when the golf club head is laying on the surface via the sole. As explained above, no combination of Beebe et al. and any other reference of record teaches or suggests such a structure. Accordingly, independent claim 23 and all claims dependent directly or indirectly thereon are allowable.

For at least the foregoing reasons, it is respectfully submitted that the pending claims are in condition for allowance. If, for any reason, the examiner is unable to allow the application in the next Office action, the examiner is encouraged to telephone the undersigned attorney at the telephone number listed below to discuss this matter.

**U.S. Serial No. 10/616,123**  
**Attorney Docket No. KMC-585**

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 11-0222.

Respectfully submitted,

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## APPENDIX A

U.S. Patent

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Sheet 3 of 4

US 6,186,903 B1

